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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,317	10/08/2003	Masafumi Dounoue	1538.1041	5477
21171 7590 09/15/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER MILLER, ALAN S	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 09/15/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/680,317

Applicant(s)

DOUNOU ET AL.

Examiner

ALAN MILLER

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 13, 14, 18 and 19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2, 13, 14, 18 and 19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date 8/29/2006, 10/8/2003
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the application filed 10/8/2003 claiming foreign benefit back to 10/9/2002.

Claims 1, 2, 13, 14, 18 and 19 are pending and have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1 and 2 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

To qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, in claims 1 and 2, applicant's method steps, registering and judging, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. There is only a nominal recitation of

technology in the claims. Thus, claims **1** and **2** are non-statutory since they recite only a nominal use of technology and may be preformed within the human mind.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims **1, 2, 13, 14, 18 and 19** are rejected under 35 U.S.C. 102(e) as being anticipated by Jilk et al. (U.S. Patent 6,859,523, hereinafter Jilk).

6. In respect to claims **1, 13 and 18**, Jilk discloses:

based on data received from a terminal of a staff member,(see at least column 7, lines 64-68 through column 8, lines 1-4, wherein workers log onto task management system) registering data concerning an activity state of said staff member (e.g. whether a worker is working on a task) (see at least column 8, lines 5-12, wherein Jilk discloses worker requests a task (i.e. activity state of said staff member)) and data concerning a settlement state of problems in a work (e.g. completion of task) that said staff member is doing (see at least column 8, lines 29-37, wherein Jilk discloses submits the resulting task result in the task management system),

into a storage device (see at least column 8, lines 31-35, wherein Jilk discloses a task submission unit),

judging suitability of said work that said staff member is doing, by using a predetermined rule, which is stored in a rule storage, for at least said activity state and said settlement state of said problems, and said data registered in said storage device; and (see at least column 8, lines 38-59; wherein Jilk discloses quality assessment (QA) (i.e. suitability of said work), managed by a quality unit that evaluates task result (activity state and settlement state of said problems), configuring QA, including worker evaluation are settable, e.g. entries in a database parameters (i.e. predetermined rules in rule storage), and at least column 25, lines 24-68, wherein Jilk further describes the Quality Unit; See also column 8, lines 60-64, wherein Jilk discloses an evaluation unit, and column 23, lines 27-68 through column 24, lines 1-23, wherein Jilk further describes the Evaluation Unit, wherein the evaluation unit evaluates worker performance from each completed task (i.e. judging suitability of said work that said staff member is doing for at least said activity state and said settlement state of said problems)),

transmitting a manager terminal data representing said suitability of said work that said staff member is doing (see at least column 9, lines 14-18, wherein the evaluation unit is coupled to the capacity manager (i.e. transmitting to a manger terminal); and see also at least column 23, lines 60-62, wherein the evaluation unit de-certifies the work for a specific task skill (i.e. suitability of work that said staff member is doing), and column 24, lines 1 – 8, wherein the de-certification (i.e. work that staff member is doing) automatically generates a review task for the worker's manager (i.e. transmitting to a manager terminal data representing said suitability of work; see also column 6, lines 56-57, wherein a manager is a system user who works as a

manager, and column 6, lines 1, wherein Jilk discloses at least one worker terminal (i.e. manager terminal)). Examiner notes that de-certification is representing suitability (e.g. worker's poor performance of a task skill) of said work that staff member is doing, and that generating a review task for the worker's manager is transmitting data representing said suitability of said work (e.g. de-certification).

7. In respect to claims **2, 14 and 19**, Jilk discloses:

based on data received from a terminal of a staff member (see at least column 7, lines 64-68 through column 8, lines 1-4, wherein workers log onto task management system), registering data concerning an activity state of said staff member (e.g. whether a worker is working on a task) (see at least column 8, lines 5-12, wherein Jilk discloses worker requests a task (i.e. activity state of said staff member)) and data concerning a settlement state of problems in a work (e.g. completion of task) that said staff member is doing (see at least column 8, lines 29-37, wherein Jilk discloses submits the resulting task result in the task management system), into a storage device (see at least column 8, lines 31-35, wherein Jilk discloses a task submission unit),

judging suitability of said work that said staff member is doing, by using a predetermined rule, which is stored in a rule storage, for at least said activity state and said settlement state of said problems, and said data registered in said storage device; and (see at least column 8, lines 38-59; wherein Jilk discloses quality assessment (QA) (i.e. suitability of said work), managed by a quality unit that evaluates task result (activity state and settlement state of said problems), configuring QA, including worker evaluation are settable, e.g. entries in a database parameters

(i.e. predetermined rules in rule storage), and at least column 25, lines 24-68, wherein Jilk further describes the Quality Unit; See also column 8, lines 60-64, wherein Jilk discloses an evaluation unit, and column 23, lines 27-68 through column 24, lines 1-23, wherein Jilk further describes the Evaluation Unit, wherein the evaluation unit evaluates worker performance from each completed task i.e. judging suitability of said work that said staff member is doing for at least said activity state and said settlement state of said problems)),

specifying either of said work, which is judged that there is no suitability and said staff member, who is doing said work, and transmitting data concerning either of the specified work and the specified staff member to a manager terminal (see at least column 23, lines 60-62, wherein the evaluation unit de-certifies the work for a specific task skill, and 24, lines 1 – 8, wherein the de-certification (work that is judged that there is no suitability) automatically generates a review task for the worker's manager (i.e. transmitting to a manager terminal data representing said suitability of work; see also column 6, lines 56-57, wherein a manager is a system user who works as a manager, and column 6, lines 1, wherein Jilk discloses at least one worker terminal (i.e. manager terminal)). Examiner notes that de-certification is representing work which is judged that there is no suitability (e.g. worker's poor performance of a task skill), and that generating a review task for the worker's manager is transmitting data representing said work (e.g. de-certification).

Conclusion

8. The prior art made of record and not relied upon considered pertinent to Applicant's disclosure.

- a. Slade et al. (U.S. Patent 4,671,772) discloses a performance appraisal and training method and system.
- b. Rassman et al. (U.S. Patent 4,937,743) discloses a method and system for monitoring and dynamically managing resources.
- c. Haq et al. (U.S. Patent 6,275,812) discloses a system for dynamic resource management.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALAN MILLER whose telephone number is (571)270-5288. The examiner can normally be reached on Mon - Thur, 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BETH BOSWELL can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALAN MILLER/
Examiner, Art Unit 3623

/Beth V. Boswell/
Supervisory Patent Examiner, Art Unit 3623